

REMARKS

This paper is filed in response to the final office action mailed on October 20, 2003. Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it reduces the number of pending claims, raises no new issues, addresses only the issue raised by the examiner in the final office action and, places this application in a condition for allowance.

The examiner acknowledges that the amendment to Formula 1 of claim 1 requiring five of the six monomer units to be present is not taught or suggested by the prior art of record. However, the Patent Office alleges that the amendment to claim 1 filed on August 7, 2003 constitutes either new matter or is a violation of the written description requirement of 35 U.S.C. § 112, first paragraph. Applicants in no way agree with this position but, has amended claim 1 to traverse this rejection.

Specifically, Example 2 on page 11 of the application clearly recites a synthesis of a polymer whereby monomer units a and b-e are present as substituent X_1 is a methyl group and Y is a diethyl ether group. Also, on page 3, lines 16-17 of the application, the monomer units b, d and e are characterized as ranging from 0 to 20mol%, 0 to 30mol% and 0 to 20mol%. Therefore, Example 2 in combination with page 3, lines 16-17 provide antecedent basis and an adequate written description for a polymer of Formula 1 where monomer unit b, d and e are "present in an amount up to and including 20%" as now recited in independent claim 1.

Example 2 and page 3 of the specification clearly convey with reasonable clarity to those skilled in the art that applicants were in possession of the polymers of Formula 1 as recited in claim 1 as of the filing of this application thereby fully satisfying the requirements of 35 U.S.C. § 112, first paragraph. "Adequate description under the first paragraph of 35 U.S.C. § 112 does not require literal support for the claimed invention . . . rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that [applicants] had in possession of the concept of what is claimed." *Ex parte Parks*, 30 U.S.P.Q.2d 1234, 1236-37 (BPAI 1993). "To satisfy the description requirement of § 112, first paragraph, an application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that appellant was in possession of the subject matter claimed . . . a statement of appellant's invention which is as broad as appellant's broadest claims is sufficient to meet this requirement." *In Re Eickmeyer*,

202 U.S.P.Q. 655, 662 (CCPA 1979). In this case, the 0-25% and 0-30% ranges set forth in the specification provide antecedent basis for the monomer units being "present" as now claimed. "*Ipsis Verbis*" is not necessary to satisfy the written description requirement of § 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had in possession of the subject matter in question." *Fujikawa v. Wattanasin*, 39 U.S.P.Q.2d 1895, 1904 (Fed. Cir. 1996).

Clearly, from Example 2 and page 3 of the application, the application provides a written description so as to convey to one of ordinary skill in the art that the applicants had in their possession a polymer of Formula 1 whereby monomer units b, d and e are "present" in an amount ranging up to 20%, 30% and 20%, respectively.

Accordingly, applicants respectfully submit that the rejection of claims 1-3 and 8-13 under 35 U.S.C. § 112, first paragraph is improper and should be withdrawn.

Applicants also note that the office action indicates the use of the term "1" in amended claim 1 constitutes new matter. However, this rejection is not elaborated. In any event, in view of the revised amendment to claim 1, applicants also respectfully submit that any "new matter" rejection imposed by the Patent Office has been traversed.

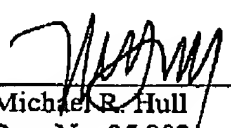
The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-9577

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By:


Michael R. Hull
Reg. No. 35,902